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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
CARY L. QUEEN ET AL.) Examiner: M. Marks
Serial No.: 07/310,252) Art Unit: 185
Filed: February 13, 1989) PETITION FOR WITHDRAWAL
For: DESIGNING IMPROVED) OF HOLDING OF ABANDONMENT
HUMANIZED IMMUNOGLOBULINS)
San Francisco, CA 94105

Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

In response to the Notice of Abandonment, mailed June 1, 1990 in the above referenced case, which notice was sent for failure to respond to an Office letter mailed Nov. 7, 1989, Applicants hereby petition for a withdrawal of the holding of abandonment, on the ground of non-receipt of the office action. Applicants respectfully request that the Notice of Abandonment be withdrawn, and that the November 7, 1989 office action be sent again, with additional time for response.

This petition is filed pursuant to MPEP § 711.03(c), and is supported by verified statements of Debra B. Hudson and Michele A. Simone, docket clerks for Applicants' attorneys, at Townsend and Townsend, San Francisco, CA. This petition is further supported by verified documentary evidence showing non-receipt of the office action in question, and further showing that another office action in a related case, mailed the same day, was received promptly and was responded to in a timely manner.

The facts surrounding non-receipt of the Office Action are outlined below:

1. U.S. Patent Application Serial No. 07/290,975 (the '975 application), was filed on December 28, 1988.
2. The above-referenced U.S. Patent Application Serial No. 07/310,252 (the '252 application), a continuation-in-part of the '975 application, was filed on February 13, 1989. The '975 application remains pending.

3. An office action requiring restriction or election in the '975 case, mailed November 7, 1989, was received by Applicants' attorneys on November 10, 1989. See Exhibit A, which is a true and complete copy of the November 7, 1989 office action in the '975 case, showing a date of receipt of November 10, 1989. See also Exhibit B, which is a true and complete copy of a print-out of Applicants' attorneys' docket sheet for the '975 case, printed out on June 8, 1990, and having an entry under the heading "P.O. Action" of "110789", showing receipt of an office action dated November 7, 1989.
4. The PTO reports that on the same day that the office action in the '975 case was mailed (November 7, 1989), an office action requiring restriction or election was also mailed in the related '252 case. See Exhibit C, which is a true and complete copy of the Notice of Abandonment in the '252 case, showing abandonment for failure to respond to an office action dated November 7, 1989.
5. No office action was received by Applicants or their attorneys, at that time, or at any time, in the '252 case. See Exhibit D, which is a true and complete copy of a print-out of Applicants' attorneys' docket sheet for the '252 case, printed out on June 8, 1990, showing no entries under the heading "P.O Action".
6. A timely response to the office action in the '975 case was mailed to the Patent Office on March 7, 1990. See Exhibit E, which is a true and complete copy of Applicants' response to the November 7, 1989 office action in the '975 case. The response was received by the Patent Office on March 12, 1990. See Exhibit F, which is a true and complete copy of the date-stamped postcard showing receipt of the response in the PTO on March 12, 1990.
7. On or about May 17, 1990, Applicants' attorneys received a telephone call from Examiner Marks, acknowledging receipt of the response in the '975 case, and stating that no response had been received in the '252 case. This was the first

indication to either Applicants or Applicants' attorneys that there had been an office action in the '252 case.

8. On June 4, 1990, Applicants' attorneys received a Notice of Abandonment for failure to respond to the November 7, 1989 office action in the '252 case. The Notice of Abandonment was mailed on June 1, 1990. See Exhibit C, showing a date of receipt of June 4, 1990.
9. Applicants diligently filed this petition upon receipt of the Notice of Abandonment.

As is apparent from these facts, there were two office actions in the related '975 and '252 cases, mailed on the same day, each requiring an election or restriction. Applicants' attorneys received only one of these actions (as evidenced by the entries on the computerized docket sheets, Exhibits B and D). Applicants timely responded to the one office action that was received. Had Applicants received or known of the existence of the second office action, it too would have been responded to in a timely way.

Applicants' attorneys have reviewed their docketing and mail handling procedures to assure that the office action had in fact never been received. The following facts reflect that review. These facts are further verified in the accompanying Verified Statements of Debra B. Hudson and Michele A. Simone, docket clerks for Applicants' attorneys at Townsend and Townsend, San Francisco, CA.

1. The following procedures and controls are utilized by Applicants' attorneys with respect to correspondence received from the Patent Office (see the accompanying Verified Statement of Debra B. Hudson):
 - i. When communications from the PTO are received in the mailroom, they are immediately date-stamped, and are then sent to the appropriate docketing department (U.S. or foreign). Mail is delivered from the mailroom directly to the docketing department early each morning.

- ii. On receiving the PTO communication in the docketing department, a docket clerk will enter the serial number of the application into the computer, to call up the appropriate docket file.
- iii. The docket clerk will put the working attorney's initials and the firm file number in red on the upper right hand corner of the document.
- iv. The docket clerk will also place a red stamp reading "Response Due" on the front of the office action, and write in large red characters the date the response is due.
- v. The docket clerk will then enter the PTO action and date, and the response due date into the computer.
- vi. The PTO communication is then immediately forwarded to the working attorney.
- vii. Entries are also made in the computer docket when communications are sent from the working attorney to the PTO.

2. The above procedures and controls were followed in the situation at hand in the following way (see the accompanying Verified Statements of Debra B. Hudson and Michele A. Simone):

- i. The docketing department received an office action in the case of Application Serial No. 07/290,975, which had been mailed on November 7, 1989, and had been date-stamped in the mailroom as received on November 10, 1989.
- ii. Upon receipt of that document, the docket clerk (Debra B. Hudson) stamped and wrote the "Response Due" date (December 7, 1989) on the front of the document in red ink, wrote the working attorney's initial and the firm file number (WMS 11823-8) in the top right hand corner of the front page, and entered the relevant information into the computer docket. She signed her initials on the front page after the Response Due date (DBH).

iii. No office action was entered into the computer docket on that date, or any other date, for the case of Application Serial No. 07/310,252.

iv. The docketing department received and entered in the computer docket a Notice of Abandonment for Application Serial No. 07/310,252, for failure to respond to an office action allegedly mailed November 7, 1989. The document was date-stamped as received on June 4, 1990. Michele A. Simone received the document, and wrote the firm file number and working attorney's initials in red in the top right hand corner of the document.

v. Ms. Simone immediately checked to see if there was any record of receipt of the November 7, 1989 office action. There was none. She then forwarded the Notice of Abandonment to the working attorney.

The above facts show that (1) Applicants' attorneys' procedures and controls are adequate to handle communications received from the PTO, and that (2) Applicants' attorneys never received the November 7, 1989 office action in the above-identified application.

Applicants therefore request that the holding of abandonment be withdrawn pursuant to MPEP § 711.03(c), and that the November 7, 1989 office action be sent again, with additional time for response. As this petition has been filed promptly after the Notice of Abandonment, no terminal disclaimer is required.

Respectfully submitted,
TOWNSEND and TOWNSEND

By W.M. Smith
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